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EXAMINER
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ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/751,436	SALIBA ET AL.
	Examiner	Art Unit	
	Siegfried E. Chencinski	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-59_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-59_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _7/09/04, 12/30/04_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☒ Other: _IDS-8/31/05_.

DETAILED ACTION

1.   In view of the Appeal Brief filed on July 15, 2005, PROSECUTION IS HEREBY
REOPENED on the basis set forth below.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth
in 37 CFR 41.20 have been increased since they were previously paid, then appellant
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner
and process of making and using it, in such full, clear, concise, and exact terms as to
enable any person skilled in the art to which it pertains, or with which it is most nearly
connected, to make and use the same and shall set forth the best mode contemplated
by the inventor of carrying out his invention.

2.   **Claims 1-59 are rejected** under 35 U.S.C. 112, first paragraph, as failing to
comply with the written description requirement. The claim(s) contains subject matter
which was not described in the specification in such a way as to reasonably convey to
one skilled in the relevant art that the inventor(s), at the time the application was filed,
had possession of the claimed invention.

A portion of the limitations added by amendment to Claims 1, 11 and 37 are not
supported by the specification. The limitation not found is "the non-user has not

registered for a service of the secure email system". This limitation was added to claim 37 prior to the final rejection dated January 27, 2005. This limitation was introduced to claims 1 and 11 as an After-Final Amendment of claims 1 and 11 on April 8, 2005. This amendment of claims 1 and 11 is phrased as follows: "wherein the recipient can be either a user or a non-user of a secure email system, wherein the non-user has not registered for a service of the secure email system.". The examiner is unable to find support for this limitation "wherein the non-user has not registered for a service of the secure email system" in the specification or in the original disclosure. The original claim 37 in the disclosure does not contain this limitation as this limitation was subsequently added by amendment. The limitation which this most recent amendment replaces in claims 1 and 11 stated "no non-user (or non-participant) has registered for a service of the secure e-mail system". The Appeal Brief claimed that this limitation is supported on specification pages 12, ll. 14-20 and 20, ll. 3-5 and 15-16. These sections of the specification do not support this prior limitation. The specification does not restrict the recipients of billing e-mails to those who have registered for a service of the secure e-mail system. The specification merely reduces the content of the billing information in the case when those whose network or communications connection do not meet the sender system's security parameters. It is not permitted to claim an unstated phenomenon in a disclosure with a positive assertion about such a feature because it is not part of the invention at the time of the application. Therefore this limitation segment in claims 1, 11 and 37 is new matter. Claims 2-10, 12-36 and 38-59 are rejected because of their dependency on claims 1, 11 and 37, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43, 49 and 52 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (US Patent 5,963,925, hereafter Kolling).

Re. Claim 1, Kolling discloses a method comprising:

- receiving bill data (Col. 8, ll. 52-53); and

- generating an email message with information including at least a portion of the received bill data (1. Email message: a) Email is short for "electronic mail". Electronic mail or email is defined by the Microsoft Computer Dictionary as "1. The exchange of text messages and computer files over a communications network, such as a local area network or the Internet, usually between computers or terminals. 2. "An electronic text message". The Electronic Payment System (EPS) is one such email system – Abstract, ll. 1-7; Col. 5, ll. 39-47; Col. 22, ll. 25-34-consumer election of address options can include an e-mail address; Col. 26, ll. 28-29; Col. 30, ll. 40-41. 2. Bill data – Col. 30, ll. 37-48),

- wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient (Abstract, ll. 1-7 – Kolling teaches a system which effects electronic presentment (i.e. delivery) of billing statements and invoices; ll. 30-31 – through "any chosen medium"; Col. 9, ll. 37-55. Kolling adjusts the amount of information to fit the medium. This suggests that there is flexibility (Col. 4, l. 63 – Col. 5, l. 67). Kolling also teaches a method and system whereby a consumer is sent a message to log on to a web site through the Internet in order to access the consumer's invoice (Col. 3, ll. 40-45). Even though this is a less efficient method for which Kolling teaches a more efficient replacement, the method still remains valid and suggests to the ordinary practitioner that if there is no secure electronic means to send the full billing information such a limited message advising the consumer recipient still has value in order to protect all the parties involved. Such a two step method could obviously be incorporated into other elements of Kolling's teaching and an ordinary practitioner of the art at the time of Applicant's invention would have

seen the obvious combination of these teachings and suggestions within Kolling. Further, Kolling teaches numerous electronic and non electronic ways for delivery of the billing message, including the Internet, which is an email method (see above). Thusly, the origination of the billing message by electronic means suggests that an email address is at least in part in the recipient's bill data file possessed by the sender, since otherwise a non electronic means would have to be used to send the billing message to the consumer recipient. It is obvious that an email address related to the recipient is also at least in part in the recipient's bill data file possessed by the second or final sender in the relay options taught by Kolling. However, it is also a part of Kolling's teaching to include means of non-electronic billing message delivery of electronic means of connection (i.e. electronic address information) are not found in the data file related to the billing recipient.),

- wherein the recipient can be either a user or a non-user of a secure email system (Kolling teaches "any chosen medium", which includes users and non-users of the original sender's secure service system, see the next limitation below),

- wherein the non-user has not registered for a service of the secure e-mail system (after final amendments are underlined). (Kolling explicitly teaches the user option in Col. 3, ll. 14-16; Col. 4, ll. 29-49; Col. 5, ll. 17-29, 42-47 (Internet includes e-mail); Col. 26, ll. 25-30) (Col. 34, ll. 35-67). This limitation is worded in such a way as to exclude the recipient's registration status with any other entity. The wording limits the referenced "non-registration" status to the sender's secure email service system which is being used for this particular message. This suggests that the recipient may be registered with other service providers, including those through whom the billing related email message might be routed to the recipient. Further, a non-user is similarly defined as someone who is not using the sender's specific system which originates the email billing message of variable content. Since Kolling provides the option of sending the billing message through a third party, such as the user's financial institution or the user's billing service, Kolling does not require users to be registered with the original sender of

the billing message. Kolling explicitly teaches the user option in Col. 3, II. 14-16;

Col. 4, II. 29-49; Col. 5, II. 17-29, 42-47 (Internet includes e-mail); Col. 26, II. 25-

30).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of

Applicant's invention to modify Kolling for the purpose of transmitting information via

email, motivated by a desire to present an improved method for delivering statement

and invoice information to consumers (Kolling, Col. 3, I. 66 – Col. 4, I. 2).

Re. Claim 2, Kolling discloses a method according further comprising: sending the

email message to the recipient (Col. 30, II. 37-41).

Re. Claim 8, Kolling discloses a method according further comprising:

- receiving the sent email message including at least a portion of the bill data at

  the recipients email address (Col. 1, I. 26; Col. 9, II. 15-16); and

- displaying at least a portion of the message in an inbox of an email client used by

  the recipient to access their email account (Col. 13, II. 20-32; Col. 18, II. 15-16;

  Col. 30, II. 37-41).

Re. Claim 10, Kolling discloses a method according further comprising: paying some or

all of the received bill by responding to the email (Abstract, II. 8-9; Col. 4, II. 30-34, 55-

59).

Re. Claim 11, Kolling discloses a data network comprising:

- a plurality of computing devices, coupled to the network, to facilitate network

  access by one or more participants (Col. 33. I. 23 – Col. 34, I. 33); and

- an email server, coupled to the data network and responsive to one or more of

  the plurality of computing devices, the email server including: a storage medium

  to store at least one financial account for each of the plurality of participants (Col.

  33. I. 23 – Col. 44, I. 33, see especially the email systems including Exchange

  Server, CCMail, etc at Col. 33, II. 25-27); and

- a financial transaction manager, coupled to the memory device and selectively

  invoked by a participant, to manage access to and manipulation of financial

  account assets to effect requested financial transactions with any <u>network</u>

participant or non-participant (Col. 34, II. 35-67), <u>wherein no non-participants</u>
<u>have registered for a service of an e-mail system supported by the email server</u>
(after final amendments are underlined).

It would have been obvious and reasonable for an ordinary practitioner of the art at the
time of applicant's invention to have understood the expression "participant(s)"
interchangeably with "users" in the context of Applicant's claims in this invention. Please
see the rejection rationale presented with the rejection of claim 1 for the reasons why
Kolling teaches and suggests the limitations of claim 11 to the ordinary practitioner of
the art at the time of Applicant's invention, especially the claim elements relating to
participants, non-participants, and users and non-users. Therefore, it would have been
obvious to an ordinary practitioner of the art at the time of Applicant's invention to
modify Kolling for the purpose of transmitting information via email through a data
network, motivated by a desire to present an improved method for delivering statement
and invoice information to consumers (Kolling, Col. 3, l. 66 – Col. 4, l. 2).

Re. Claim 12, Kolling discloses a data network wherein the financial account is
electronically linked to an account of the participant at a financial institution (Fig. 1; Col.
4, II. 63-65).

Re. Claim 13, Kolling discloses a data network wherein the account of the participant is
one of a checking account, a savings account, a line of credit, and a money market
account maintained by a banking institution (Col. 18, l. 58).

Re. Claim 14, Kolling discloses a data network wherein the financial account is one of
a checking account, a savings account, a line of credit, and a money market account
maintained by a banking institution (Col. 18, l. 58).

Re. Claim 15, Kolling discloses a data network wherein the computing devices are one
or more of a personal computer, a personal digital assistant, a kiosk, a telephone and a
set-top box having sufficient resources to enable the
participant to access the data server and utilize the financial transaction
manager (Col. 5, II. 47-50; Col. 34, II. 1-14).

Re. Claim 16, Kolling discloses a data network further comprising an email system having a plurality of data servers including the data server (Col. 10, ll. 32-34; Col. 14, l. 8-10; Col. 31, ll. 59-61; Col. 33, ll. 23-29).

Re. Claim 17, Kolling discloses a data network wherein the data server is controlled by a financial institution (Col. 1, ll. 11-15; Col. 5, ll. 42-53).

Re. Claims 18, Kolling discloses a data network wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets (Col. 9, ll. 15-25).

Re. Claims 19, Kolling discloses a data network wherein each of the first and second participants are individual consumers, a business, or a combination of each (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claims 25, Kolling discloses a data network wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claims 28, Kolling discloses a data network wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

Re. Claim 36, Kolling discloses a storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager according to claim 11 (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

Re. Claim 37, Kolling discloses an email system, selectively accessed by users on a data network using a computing device, the email system comprising:

- a user interface, through which a user accesses an account associated with the user (Col. 19, ll. 27-28; Col. 26, ll. 57-59; Col. 25, ll. 10-26; Col. 26, ll. 25-30);

- one or more storage devices, to store and maintain account information for each of the users (after final amendments are underlined) (Col. 33, ll. 43-67); and

- a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein the non-user of the email system has not registered for a service of the email system (Col. 34, ll. 35-67).

Please see the rejection rationale presented with the rejection of claim 1 for the reasons why Kolling teaches and suggests the limitations of claim 37 to the ordinary practitioner of the art at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to modify Kolling for the purpose of transmitting information via an email system, motivated by a desire to present an improved method for delivering statement and invoice information to consumers (Kolling, Col. 3, l. 66 – Col. 4, l. 2).

Re. Claim 39, Kolling discloses an email system wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant (Col. 33, l. 43 – Col. 34, l. 67).

Re. Claim 40, Kolling discloses an email system wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets (Col. 9, ll. 15-25).

Re. Claim 43, Kolling discloses an email system wherein each of the first and second users are individual consumers, or businesses (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claim 49, Kolling discloses an email system wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claim 52, Kolling discloses an email system wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

4.   **Claims 3-6 & 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over
Kolling in view of Blossman et al. (US Patent 6,721,783 B1, hereafter Blossman).
RE. Claim 3, Kolling discloses a method wherein the step of generating comprises
constructing the email message to include at least a URL (an internet address) of where
bill data may be confidentially viewed (Col. 19, II. 7-13, 26-28; Also Col. 3, II. 40-46).
Kolling do not explicitly disclose a method wherein the step of generating comprises:

- determining whether the recipient is a participant in a secure email network; and
- constructing the email message to include at least an address of where the bill
  data may be confidentially viewed if the recipient is a non-user of the secure
  email system.

However, Blossman disclose

- determining whether the recipient is a participant in a secure email network (Col.
  4, II. 1-9; Col. 15, II. 32-35); and
- constructing an email message to an email user without regard to the security
  status of the email user's address or network (Col. 2, II. 40-46).

The ordinary practitioner would recognize the ubiquitous use of URL's which provide an
opportunity for any operator of a web site, such as a biller or biller agent's web site, to
notify an e-mail user to log on to an internet address (by direct link or not) for many
purposes, such as for viewing secure bill data if the email user's network is of an
unknown security level. Kolling discloses such an arrangement in Col. 3, II. 40-46. An
unknown security condition would be the case if the email user is not registered with the
biller or the biller's agent. It would have been obvious to an ordinary practitioner of the
art at the time of Applicant's invention to have combined the art of Kolling with that of
Blossman in order to reduce the barriers to increased usage by individuals and smaller
business entities which exist in conventional electronic bill presentment and/or payment
system (Blossman, Col. 3, II. 55-58).
Re. Claim 4, Kolling do not explicitly disclose a method further comprising: constructing
the email message to include substantially all of the bill data along with financial
Multipurpose Internet Multimedia Extensions (MIME) elements which enable the

recipient to manage a financial account. However, Blossman et al. disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, II. 41-44, 50-55; Col. 12, II. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman in order to send electronically-mailed financial billing and statement notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, II. 55-58).

Re. Claim 5, Kolling disclose a method wherein the MIME elements enable the recipient to pay all or part of the received bill (Col. 3, II. 14-16. A bill can be paid once it is received by the payer, especially when there is confidence in the integrity of the statement data.).

Re. Claim 6, Kolling discloss a method wherein the MIME elements enable the recipient to establish and manage a financial account (The security features of the MIME elements create greater confidence in the data and in the integrity of the transmissions, thus encouraging the recipient to make a return transmission with payment information).

Re. Claim 9, Kolling disclose a method further comprising: displaying the email message in the email client of the recipient, upon recipient access of the email message, that enable the recipient to pay some or all of the received bill (Abstract, II. 8-9; Col. 4, II. 30-34, 38-41, 55-59). Kolling do not explicitly disclose a method wherein the email message includes financial Multipurpose Internet Mail Extension (MIME) elements. However, Blossman disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, II. 41-44, 50-55; Col. 12, II. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman et al. in order to send electronically-mailed financial billing and statement

notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, ll. 55-58).

5.   **Claims 26, 27, 38, 50, 51 & 59 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Cornelius et al. (US Patent 6,629,081, hereafter Cornelius).

Re. Claims 26&27, Kolling do not explicitly disclose a data network, and an e-mail system, wherein the network service is

- **Re. Claims 26 and 50,** an electronic auction service.
- **Re. Claims 27 and 51,** an electronic retail service.
- **Re. Claim 38,** an email system, wherein the user interface is a series of instructions issued to a computing device of the user to create a web page at the computing device.

However, Cornelius disclose a data network wherein the network service is

- an electronic auction service (Fig. 8; Col. 18, ll. 13-19).
- an electronic retail service (Fig. 3, Col. 3, ll. 65-67).
- an email system wherein the user interface is a series of instructions issued to a computing device of the user to create a web page at the computing device (Col. 192, ll. 21-39; Col. 216, ll. 3-63).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of Cornelius in order to provide improved statement or billing delivery means to leverage existing systems (such as existing electronic bill payment systems) to participants in a transaction (Kolling, Col. 4, ll. 2-6).

Re. Claim 59, Kolling et al. disclose a storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager of an email system (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

6.   **Claims 29, 31, 53 & 55 are rejected** under 35 U.S.C. 103(a) as being

unpatentable over Kolling in view of Ganesan (US Patent 6,678,664 B1, hereafter

Ganesan).

Re. Claims 29 & 53, Kolling do not explicitly disclose a data network and an e-mail

system, wherein the financial transaction manager determines whether to honor the

participants payment when the specified account has insufficient assets to cover the

requested payment. However, Ganesan discloses a data network wherein the financial

transaction manager determines whether to honor the participants payment when the

specified account has insufficient assets to cover the requested payment (Col. 18, ll. 5-

23). Ganesan discloses the standard practice of honoring a check if adequate prior

credit arrangements are made. In the electronic banking era these facilities include a

line of credit or a credit card account of the payer arranged with the financial institution

to back up a payment account such as a checking account. It would have been obvious

to an ordinary practitioner of the art at the time of Applicant's invention to have

combined the art of Kolling with that of Ganesan in order to reduce, if not eliminate the

barriers to increased usage by individuals of electronic bill presentment and/or payment

systems (Ganesan Col. 4, ll. 11-15).

Re. Claims 31 & 55, Kolling et al. do not explicitly disclose a data network and an e-

mail system, wherein the financial transaction manager automatically accesses a line of

credit associated with the participant to honor the payment when the specified account

has insufficient assets to cover the requested payment. However, Ganesan discloses a

data network wherein the financial transaction manager automatically accesses a line of

credit associated with the participant to honor the payment when the specified account

has insufficient assets to cover the requested payment (Col. 18, ll. 5-23). It would have

been obvious to an ordinary practitioner of the art at the time of Applicant's invention to

have combined the art of Kolling with that of Ganesan in order to reduce, if not eliminate

the barriers to increased usage by individuals of electronic bill presentment and/or

payment systems (Ganesan, Col. 4, ll. 11-15).

7.   Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling
and Ganesan as applied to claim 31 above, and further in view of Blossman.

Re. Claim 32, neither Kolling nor Ganesan explicitly disclose a data network, wherein
the financial transaction manager notifies the participant of the insufficient funds and
that the line of credit has been accessed to honor the requested payment. However,
Blossman discloses a data network wherein the financial transaction manager notifies
the participant of the insufficient funds and that the line of credit has been accessed to
honor the requested payment (Col. 9, ll. 11-27). It would have been obvious to an
ordinary practitioner of the art at the time of Applicant's invention to have combined the
art of Kolling and Ganesan with that of Blossman in order to send electronically mailed
bank advices of electronic bill presentment and/or payment systems events to
individuals (Blossman, Col. 3, ll. 55-58).

8.   Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling
and Ganesan as applied to claim 29 above, and further in view of McCoy et al. (US
Patent 5,649,116, hereafter McCoy).

Re. Claim 30, neither Kolling nor Ganesan explicitly disclose a data network and an e-
mail system, wherein the financial transaction manager utilizes a growing trust model to
determine whether to honor the payment when the specified account has insufficient
assets to cover the requested payment. However, McCoy disclose a data network
wherein the financial transaction manager utilizes a growing trust model to determine
whether to honor the payment when the specified account has insufficient assets to
cover the requested payment (Abstract ll. 8-14). McCoy teaches a formula-based
threshold for honoring a payment request when an account has insufficient assets to
cover a requested payment. It would have been obvious to an ordinary practitioner of
the art at the time of Applicant's invention to have combined the art of Kolling and
Ganesan with that of McCoy in order to control risk in an automated electronic payment
system (McCoy, Col. 2, l. 66 – Col. 3, l. 1).

9.   **Claim 54 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling as applied to claim 52 above, and further in view of in view of McCoy.

Re. Claim 54, Kolling do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment. However, McCoy disclose a data network wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment (Abstract ll. 8-14). McCoy teaches a formula-based threshold for honoring a payment request when an account has insufficient assets to cover a requested payment. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of McCoy et al. in order to control risk in an automated electronic payment system (McCoy, Col. 2, l. 66 – Col. 3, l. 1).

10.   **Claims 22, 23, 46 & 47 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Weatherly et al. (US Patent 6,049,784, hereafter Weatherly).

Re. Claims 22,23,46&47, Kolling disclose financial transactions with financial institutions such as banks and brokerage firms and the financial activities consumers engage in therewith (Col. 1, ll. 26-27; Col. 3, l. 20; Col. 5, ll. 50-51). Kolling do not disclose

- **Re. Claims 22&46,** a data network and an e-mail system, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.

- **Re. Claims 23&47,** a data network and an e-mail system, wherein the assets are received from a brokerage at the request of the participant.

However, Weatherly disclose

- **Re. Claims 22&46,** a data network, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant (Col. 5, ll. 51-56).
- **Re. Claims 23&47,** a data network, wherein the assets are received from a brokerage at the request of the participant (Col. 5, ll. 51-56).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have recognized that electronic deposits can be arranged to be made by or on behalf of any party, including individuals and businesses, and in recognition, to have combined the art of Kolling with that of Weatherly in order to send electronically-mailed remittances in an efficient, reliable and timely manner (Weatherly, Col. 13, ll. 39-42).

11.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Blossman as applied to claim 3 above, and further in view of Cornelius et al. (US Patent 6,629,081, hereafter Cornelius) and Kahn et al. (US Patent 6,401,079 B1, hereafter Kahn).

Re. Claim 7, neither Kolling nor Blossman explicitly disclose a method, wherein the step of determining comprises:

- identifying a domain name from the email address; and
- cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email system.

However, Cornelius et al. disclose a method, wherein the step of determining comprises: identifying a domain name from the email address (Col. 24, ll. 10-24); and Kahn disclose a method of cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network (Col. 22, ll. 15-24). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Blossman with that of Cornelius and Kahn in order to help keep customers' billing data secure in a computer automated billing method.

12.   Claims 24 & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Weatherly as applied to claims 22 & 46 above, and further in view of Kahn.

Re. Claims 24&48, neither Kolling nor Weatherly explicitly disclose a data network and an e-mail system wherein the assets are received from an employer as compensation to the participant. However, Kahn disclose a network wherein the assets are received from an employer as compensation to the participant (Col. 12, II. 5-10). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Weatherly with that of Kahn in order to offer customers a computer automated financial management system which also provides employers with the flexibility and control of an automated standalone payroll system (Kahn, Col 4, II. 64-67).

13.   Claims 20, 21, 44 & 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Slotznick (US Patent 5,983,200).

Re. Claims 20, 21, 44 & 45, Kolling does not explicitly disclose

- **Re. Claims 20&44,** a data network and an e-mail system, wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants.
- **Re. Claims 21&45,** a data network and an e-mail system, wherein the second participant is identified by one of a name, an alias, or an email address.

However, Schlotznick discloses a data network wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants (Col. 18, II. 34-36, 51-52); and a data network according to claim 20, wherein the second participant is identified by one of a name, an alias, or an email address (Col. 18, II. 34-52). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Slotznick because Kolling specifically calls for

incorporating Hilt et al. into Kolling's teaching to speed the execution of many tasks (Slotznick, Col. 3, ll. 48) in the providing of full-circle electronic financial transactions for billers and consumers (Kolling, Col. 4, ll. 36-38).

14.   Claims 33, 41, & 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Kahn.

Re. Claims 33, 41 & 56, Kolling do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant. However, Kahn disclose a data network and e-mail system wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant where the participants are an employer, a payment service, the employer's bank and the employee payee who can receive a paper check instead of an electronic payment which is authorized by the employer payer (Col. 12, l. 61 – Col. 13, l. 8). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Kahn to provide flexibility in the making of an automated payment (Kahn et al., Col. 4, ll. 64-67).

15.   Claims 34 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling and Kahn as applied to claim 33 above, and further in view of Wells Fargo Online (See item U. in USPTO Form 892).

Re. Claim 34&57, neither Kolling nor Kahn explicitly disclose a data network and an e-mail system wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account. However, Wells Fargo Online discloses since 1997 the inclusion of a URL where the recipient can establish an account. The enclosed screen shots from Wells Fargo Online's URL are dated 1998. The Examiner has been doing business with Wells Fargo Bank in the San Francisco area since 1991 and has personally received a wide variety of WFB promotional material, computer printed statements, business cards and

letterhead in the mail, at bank branches and from bank employees with the URL imprinted on them at least since the late 1990's. URL's became a standard component of contact information in American business, including in banking, during the 1990's. A bank issuing payroll checks would be a bank where the recipient could establish an account. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have included a bank's URL with a bank's address information on electronic or paper checks to convey a means of contact which has become increasingly popular in banking and the general business community during the 1990's in order to attract some of the growing millions of computer users to online banking with its own institution by presenting a convenient opportunity to do so. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling and Kahn with that of the Wells Fargo Online art to include URL addresses in the providing of full-circle electronic financial transactions for billers and consumers (Kolling, Col. 4, ll. 36-38).

16.   Claims 35 & 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Kahn and Wells Fargo Online as applied to claims 34 & 41 above, and further in view of Krishan et al. (US Patent 6,442,529 B1, hereafter Krishan).
Re. Claim 35, 42 & 58, none of Kolling, Kahn or Wells Fargo disclose a data network and an e-mail system, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Krishan disclose the long established practice of offering a free service product as an incentive for a prospect to try a service (Front Page, OTHER PUBLICATIONS: Simon Debartol, "Microsoft to Offer Free Internet to 32 Million Michigan Households", Indianapolis Star and News, Dec. 02, 1997.). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Kolling, Kahn and Wells Fargo with the teaching of Krishan in order to include the printing of an offer of free assets on a check, credited to a newly established account created by the recipient of the check as a method of providing advertising and information content on a user's desktop screen (Krishan, Col. 3, ll. 16-18).

17.   Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Kahn as applied to claim 41 above, and further in view of Krishan.

Re. Claim 42, neither Kolling nor Kahn disclose a data network and an e-mail system, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Krishan disclose the long established practice of offering a free service product as an incentive for a prospect to try a service (Front Page, OTHER PUBLICATIONS: Simon Debartol, "Microsoft to Offer Free Internet to 32 Million Michigan Households", Indianapolis Star and News, Dec. 02, 1997.). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Kolling and Kahn with the teaching of Krishan in order to include the printing of an offer of free assets on a check, credited to a newly established account created by the recipient of the check as a method of providing advertising and information content on a user's desktop screen (Krishan, Col. 3, II. 16-18).

Response to Arguments

18.   Applicant's arguments filed as an Appeal Brief on July 21, 2005 with respect to claims 1, 11 and 37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed on July 21, 2005 with respect to claims 3, 4-6, 7 and 9 have been fully considered but they are not persuasive.

ADMINISTRATIVE NOTE: As a courtesy to Applicant, the examiner has accepted the amendments to claims 1 and 11 which Applicant has inadvertently or improperly included in his Appeal Brief.

A. Rejections under 35 U.S.C. 112 – 1st

ARGUMENT: Applicant argues that

1. The "Examiner has misinterpreted the claims" in this rejection (p. 11, l. 15).

2. '... the features of claim 1 which recite "wherein <u>no non-user had</u> registered for a service of the secure e-mail system" and claim 11 which recite "<u>wherein no non-participants have registered for a service of an e-mail system supported by the email server</u>" are supported by the specification' (p. 13, ll. 5-8).

RESPONSE:

Applicant is referred to the above rejection of claims 1, 11 and 37 under 35 USC 112 – First Paragraph in which the examiner explains why this limitation is defined as new matter. The specification does not make a statement defining the registration status of the non-user or non-participant either way. Close reading of Applicant's various extracts of the specification in the Arguments fails to identify these limitations in the excerpted sections of the specification. The examiner's prior search in the specification for this support also had failed to locate support in the specification or in the entire disclosure when this limitation was stated as a double negative.

B.   **Rejections under 35 U.S.C. 103(a)**

ARGUMENT: Re. Claims 3, 4-6 and 9:

1. Kolling requires registration before a relationship is established. Blossman does not cure the defects of Kolling, namely with regard to users and non-users (p. 22, ll. 13-15).

2. Re. Claim 3, 'Blossman does not teach or suggest "constructing email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email system" (p. 22, ll. 21-24); and the examiner has not made a proper *prima facie* case of obviousness in rejecting this claim because "the combination of Kolling and Blossman does not teach or suggest each and every element of Claim 3. (p. 23, ll. 12-13).

RESPONSE:

1. The rejection of claim 1 above demonstrates that Kollman does not require registration before a relationship is established, although registration is one option taught by Kollman.

2. The limitation of claim 3 which Applicant is arguing is not taught or suggested by Bossman is actually rejected under the 35 U.S.C.103(a) obviousness combination

statute. As such, Bossman is only relied upon for one component of this limitation, namely "constructing an email message to an email user without regard to the security status of the email user's address or network (Col. 2, II. 40-46)". The address component of this limitation is relied upon in Kolling, as stated in the above rejection of claim 3. The rejection is based on the determination that the ordinary practitioner of the art would have found it obvious to have combined the art of Kolling with the art of Blossman, as more fully stated in the rejection of claim 3, above.

Regarding the establishment of a proper prima facie case of obviousness, MPEP 2143.01,I. cites the following case law guidance for the examiner's identifying motivation for the ordinary practitioner to combine teachings from a plurality of references:

(1) "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art."

(2) "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (underlining added). In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

(3) 'Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art (underlining added)." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)'.

In the instant case, the examiner has met these criteria. The nature of the problem Is solved through the combination of the teachings of the prior art of Kolling and Blossman and the knowledge of the one of ordinary skill. The prior art was concerned with the nearly same or very similar nature of the problem and the area of application,

namely the electronic communication of billing information, there is very closely related teaching in the prior art, the motivation of similar purpose is clearly stated in the prior art, and it is obvious the ordinary practitioner of the art would have seen the relevance of the combination of the prior art teachings with his own knowledge as obvious to the solution of the problem to be solved.

ARGUMENT: Re. claim 7,

(a) "... the cited portion of Cornelius does not teach or suggest identifying a domain name from an email address" (p. 24, ll. 8-9).

(b) "... the listing of multiple security techniques does not teach or suggest identifying a domain name from an email address" (p. 24, ll. 16-17).

RESPONSE:

The Microsoft Computer Dictionary defines an email address as "A string that identifies a user so that the user can receive Internet e-mail .... (including) the host name and domain name of the email server". This claim merely makes use of functional features built into the electronic communications system. Cornelius is merely cited as a direct application of these features in electronic commerce, which is the subject of Applicant's invention.

Conclusion

19.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

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or (571)*273-8300* [Official communications; including After Final communications

labeled "Box AF"]

(571) 273-6792   [Informal/Draft communications, labeled "PROPOSED" or

              "DRAFT"]

Hand delivered responses should be brought to the address found on the above

USPTO web site in Alexandria, VA.

SEC

April 3, 2006

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